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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,348	03/12/2004	Kurt. P. Haldeman	CDR-02-021	5612

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EXAMINER	
CHAN, WING F	

ART UNIT	PAPER NUMBER
2643	

DATE MAILED: 03/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/798,348	HALDEMAN ET AL.	
	Examiner	Art Unit	
	Wing F. Chan	2643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-23 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-23 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 3/12/04 is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of copending Application No. 10/699,823. Although the conflicting claims are not identical, they are not patentably distinct from each other because directed to the same method and system for providing communication services to a hearing-impaired party using instant/text messaging.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4, 6-9, 11--23 are rejected under 35 U.S.C. 102(b) as being anticipated by Hyziak et al (US PUB. NO. 2002/0057765 hereinafter Hyziak).

Hyziak teaches a system, computer readable medium (memory) and method for establishing communications with a wireless device (e.g. 12) associated with a hearing impaired party (e.g. 20). Hyziak teaches receiving a request for connection from the wireless device, forwarding the request to a communication assistant (node 16 and text interface 34 which functions as a [automated] communication assistant to provide text-to-speech, speech-to-text conversion), establishing a full duplex data link (communication network 14) with the wireless device. See abstract, Figs. 1-4, [0008] – [0067] for example.

5. Claims 1, 4, 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Steel, Jr. (US PUB. NO. 2004/0111268 with an effective filing date of Nov. 6, 2002, hereinafter Steel).

As to claims 1, Steel discloses a system and method for providing communication as claimed; see Fig. 5, paragraphs 0023 to 0047 for example. Steel teaches receiving a call request from a hearing-impaired party for establishing a call with a hearing party (e.g. [0032]-[0033], identifying a communication assistant (e.g.

[0026, 0035, 0036]), also as is conventional in the art, a communication assistant requests the called party telephone number from the hearing-impaired party, e.g. see Steel [0021], forwarding the call to the communication assistant (e.g. [0027, 0028, 0039]), establishing a link to the hearing-impaired party by the communication assistant (e.g. [0040, 0041, 0047), establishing a link to the hearing party by the communication assistant (e.g. [0042, 0044]), generating instant (text) messages (e.g. [0047, 0062]), transmitting the instant messages to the hearing-impaired party.

As to claim 4, see Steel [0044] for example.

As to claim 6, see Steel [0006, 0023, 0049] for example.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 5, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hyziak in view of Battin et al (US PUB. NO. 2002/0199019 filed 6/22/01 hereinafter Battin).

As to claim 5, Hyziak teaches the communication is via the Internet using packet-switched network, see [0011] for example. Hyziak differs from the claimed invention in not disclosing the request is for a socket connection received via a packet-switched network. However, it is old and well known in the art that socket connection requests are used in packet-switched network to establish connections, for example see Battin Fig. 7, [0023], [0026] for example. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hyziak to comprise request for socket connection in order to establish a connection via packet-switched (Internet) networks as is conventional in the art.

9. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Steel in view of Battin et al (US PUB. NO. 2002/0199019 filed 6/22/01 hereinafter Battin).

As to claim 5, Steel teaches the communication is via the Internet using packet-switched network, see [0006, 0023] for example. Steel differs from the claimed invention in not disclosing the request is for a socket connection received via a packet-switched network. However, it is old and well known in the art that socket connection

requests are used in packet-switched network to establish connections, for example see Battin Fig. 7, [0023], [0026] for example. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Steel to comprise request for socket connection in order to establish a connection via packet-switched networks as is conventional in the art.

10. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Steel in view of Hamilton (US PAT. NO. 6,801,613 filed Aug. 31, 2000).

As to claim 7, Steel differs from the claimed invention in not disclosing the voice link from the communication assistant to the hearing party comprise a voice over Internet Protocol (VOIP) link. However, it is old and well known in the art to use voice over Internet Protocol link in ACD systems as an alternative since VOIP link provides cost and bandwidth advantages over traditional PSTN and VOIP also provides both data and voice over the same network, for example see Hamilton col. 20 lines 36-58. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Steel's voice link from the communication assistant to the hearing party comprise a voice over Internet Protocol (VOIP) link to provide cost and bandwidth advantages over traditional PSTN.

11. Claims 2, 3, 8, 9, 11, 15, 16, 18-20, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steel in view of Hyziak et al (US PUB. NO. 2002/0057765 hereinafter Hyziak) and Carey et al (US PAT. NO. 6,714,793 filed March 6, 2000).

As to claims 2, 3, 8, 9, 15, 18-20, 23, Steel differs from the claimed invention in not disclosing a wireless device associated with the hearing-impaired party transmits the text message. However, it is old and well known in the art for a hearing-impaired party to communicate with a remote party through a relay center using a wireless device and be free from wired line system constrains, for example see Hyziak's abstract, [0008]. It is also old and well known in the art to use a wireless device to provide instant (text) messaging, for example see Carey's abstract, col. 1 line 46 to col. 2 lines 63. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Steel to comprise a wireless device associated with the hearing-impaired party to transmit the text message to allow the hearing-impaired party to communicate with a non-TDD user virtually anywhere without being constrained by a wire line system.

As to claim 11, see Steel [0006, 0023] for example.

As to claim 16, see Steel [0044] for example.

12. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steel, Hyziak and Carey as applied to claims 2, 3, 8, 9, 15, 16, 18-20, 23 above, and further in view of Hamilton (US PAT. NO. 6,801,613 filed Aug. 31, 2000).

As to claim 12, Steel differs from the claimed invention in not disclosing the voice link from the communication assistant to the hearing party comprise a voice over Internet Protocol (VOIP) link. However, it is old and well known in the art to use voice over Internet Protocol link in ACD systems as an alternative since VOIP link provides

cost and bandwidth advantages over traditional PSTN and VOIP also provides both data and voice over the same network, for example see Hamilton col. 20 lines 36-58. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Steel's voice link from the communication assistant to the hearing party comprise a voice over Internet Protocol (VOIP) link to provide cost and bandwidth advantages over traditional PSTN.

As to claim 13, the call between the hearing-impaired party, communication assistant and hearing party is a conference call.

As to claim 14, the examiner takes Official notice that TDD relay services comprises voice carry over environment and speech-to-speech environment when a communication assistant communicates with the hearing party, and when a hearing but speech impaired person is involve, the relay call is in a "HCO" or "hearing carry over" relay call environment.

13. Claims 17, 21, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steel, Hyziak and Carey as applied to claims 2, 3, 8, 9, 15, 16, 18-20, 23 above, and further in view of Duffin (US PAT. NO. 5,991,723).

Steel differs from the claimed invention in not disclosing the processor automatically generate text messages corresponding to the voice messages and automatically generate voice messages corresponding to the text messages and transmit the automatically generated messages to both parties.

However, it is old and well known in the art to provide a processor that automatically generate text messages corresponding to the voice messages and automatically generate voice messages corresponding to the text messages and transmit the automatically generated messages to both parties to overcome the disadvantages such as limited number of operators (communication assistants), operators being under utilized, added expense, lacks privacy, etc., for example see Duffin Figs. 1-2, abstract, col. 1 lines 5-63, col. 4 lines 50-60. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Steel to comprise a processor that automatically generate text messages corresponding to the voice messages and automatically generate voice messages corresponding to the text messages and transmit the automatically generated messages to both parties to overcome the disadvantages such as limited number of operators (communication assistants), operators being under utilized, added expense, lacks privacy, etc. Furthermore, it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

14. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Steel, Hyziak and Carey as applied to claims 2, 3, 8, 9, 15, 16, 18-20, 23 above, and further in view of Battin et al (US PUB. NO. 2002/0199019 filed 6/22/01 hereinafter Battin). As to claim 5, Steel teaches the communication is via the Internet using packet-switched network, see [0006, 0023] for example. Steel differs from the claimed

invention in not disclosing the request is for a socket connection received via a packet-switched network. However, it is old and well known in the art that socket connection requests are used in packet-switched network to establish connections, for example see Battin Fig. 7, [0023], [0026] for example. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Steel to comprise request for socket connection in order to establish a connection via packet-switched networks as is conventional in the art.

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Morton (US PAT. NO. 6,480,484) discloses an internet-intranet greeting service.

Bossi et al (US PAT. NO. 6,421,425) discloses an automated communications assistant for the sound-impaired.

Sollee et al (US PAT. NO. 6,757,732) discloses text-based communications over a data network.

Yue (US PAT. NO. 6,628,967) discloses a wireless communication device capable to transmit/receive TTY/TDD messages with variable data rate.

Dorbecker et al (US PAT. NO. 6,611,804) discloses a universal TTY/TDD device for robust text and data transmission via PSTN and cellular phone networks.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wing F. Chan whose telephone number is 703-305-4732. The examiner can normally be reached on Monday to Friday from 9 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on 703-305-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wing F. Chan
Primary Examiner
Art Unit 2643

2/23/05